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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/622,360 | 07/17/2003 | Wolfgang Kalthoff | 2058.213US1 | 5356 |
| 50400 7590 02/10/2009 SCHWEGMAN, LUNDBERG & WOESSNER/SAP P.O. BOX 2938 MINNEAPOLIS, MN 55402 | | | | |
| EXAMINER | | | | |
| DAILEY, THOMAS J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2452 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/622,360

Applicant(s)

KALTHOFF ET AL.

Examiner

Thomas J. Dailey

Art Unit

2452

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 January 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,5,6 and 18-87.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kenny S Lin/
Primary Examiner, Art Unit 2452

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed with respect to the prior art rejections of the claims have been fully considered but they are not persuasive.

The applicant argues with respect to the independent claims that the combination of Carter (US Pat. 5,418,945) and Hurvig (US Pat. 5,418, 945) fails to disclose or suggest "reversing the locked data set and the unlocked data set at the second entity, such that the locked data set becomes an unlocked data set being available for modification and the unlocked data set becomes a locked data set being protected from modification."

The examiner disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, Carter discloses transmitting a locked data set to a second entity (column 5, lines 18-26) and reversing the locked data set at the second entity, such that the locked data set becomes an unlocked data set being available for modification (column 5, lines 18-26, client checks out file group for alteration, i.e. it can alter the file group that is locked by the server) and Hurvig discloses a stored data set including an unlocked data set being available for modification (Fig 4, label 208, server stores modifiable database), transmitting the unlocked data set to a second entity (column 9, lines 14-24, file stored in database is transmitted), and reversing the unlocked data set at the second entity such that the unlocked data set becomes a locked data set being protected from modification (column 9, lines 14-24, if a process is given read-only access to a transmitted, this reads on a reversal of the unlocked data, as the file was modifiable at the server, but when stored at the remote process the file can only be read).

Therefore, to one of ordinary skill in the art at the time of the invention, the combination of Carter and Hurvig would disclose a stored data set including both unlocked and locked data sets, because to one of ordinary skill in the art "a stored data set" may include differing types of data (e.g. unlocked and locked data given Carter's and Hurvig's teachings) and simply combining the two data sets into one was a known technique and would have yielded predictable results. Further, transmitting and then reversing the locked and unlocked data sets would also have been disclosed by the combination of Carter and Hurvig by the same logic, see above citations.

Additionally, the combination of Carter and Hurvig would have been obvious as a person of ordinary skill the art has good reason to pursue the known options within his or her technical grasp (combining Carter's locked data set with Hurvig's unlocked data set) and if this leads to anticipated success, it is likely the product not of innovation, but of ordinary skill and common sense.

The applicant further contends that combining Hurvig and Carter would not yield the claimed method because Carter teaches transferring a copy of a file group and then preventing access to the corresponding master file group by other clients and Hurvig teaches granting a process an opportunistic lock on a file to prevent other processes from obtaining a copy of the file.

The examiner disagrees and notes the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, as elaborated on above, one of ordinary skill in the art would have viewed the combination of Carter and Hurvig as obvious and such a combination would have yielded the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.

/T. J. D./

Examiner, Art Unit 2452.